

CT



UNITED STATES PATENT AND TRADEMARK OFFICE

HC

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,274	06/22/2000	Karl Andrew Garrill	PG4114	7879

7590 04/09/2003

Glaxo Wellcome Inc  
P O Box 13398  
Five Moore Drive  
Research Triangle Park, NC 27709

EXAMINER

FOSTER, JIMMY G

ART UNIT	PAPER NUMBER
----------	--------------

3728

DATE MAILED: 04/09/2003

25

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/599,274

Applicant(s)  
Garrill et al.

Examiner  
Jimmy G. Foster

Art Unit  
3728



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-16 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 23 6) ☐ Other:

Art Unit: 3728

1. Claims 1-10 and 12-16 distinguish over the prior art.

2. Claims 1-6 and 12-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-9, 21 and 25 (copending claims) of copending Application No. 10/071,674. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to have made the invention of the present claims upon making the invention of the copending claims. The copending patent claims recite a drug and a HFA propellant in a pressurized container which is packaged with a desiccant in a pouch.

In addition, inasmuch as the subject matter of the copending claims is all to substantially the same disclosed embodiment, the examiner asserts that it would have further been obvious to have combined the various features claimed in the copending dependent claims in order to make the subject matter of the presently claimed invention in each of the claims of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 3728

3. Claims 1-6 and 12-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-5, 8, 9, 12, 14, 18 and 28 (copending claims) of copending Application No. 09/971,799. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to have made the invention of the present claims upon making the invention of the copending claims. The patent claims recite a drug and a HFA propellant in a pressurized container which is packaged with a desiccant in a pouch.

In addition, inasmuch as the subject matter of the copending claims is all to substantially the same disclosed embodiment, the examiner asserts that it would have further been obvious to have combined the various features claimed in the copending dependent claims in order to make the subject matter of the presently claimed invention in each of the claims of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented

4. Claims 1-4 and 12-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-4, 19 AND 20-22 (copending claims) of copending Application No. 10/311,819. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to

Art Unit: 3728

have made the invention of the present claims upon making the invention of the copending claims. The copending claims recite a drug and a HFA propellant in a pressurized container which is packaged in a pouch. Claim 19 calls for a moisture absorbent.

In addition, inasmuch as the subject matter of the copending claims is all to substantially the same disclosed embodiment, the examiner asserts that it would have further been obvious to have combined the various features claimed in the copending dependent claims in order to make the subject matter of the presently claimed invention in each of the claims of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented

5. Claims 1-10, 12-14 and 16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 and 12-14 (copending claims) of copending Application No. 10/312,073. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to have made the invention of the present claims upon making the invention of the copending claims. The copending claims recite a drug and a HFA propellant in a pressurized container which is packaged together with a moisture absorbent in a pouch.

Art Unit: 3728

In addition, inasmuch as the subject matter of the copending claims is all to substantially the same disclosed embodiment, the examiner asserts that it would have further been obvious to have combined the various features claimed in the copending dependent claims in order to make the subject matter of the presently claimed invention in each of the claims of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. For contacting the PTO by phone, the following contact numbers may be used:

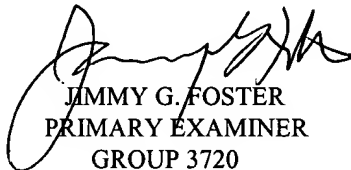
For tracking of papers and association of papers with cases --  
Customer Service. . . (703)306-5648  
For matters regarding examination -- Examiner:  
Jim Foster . . . . . (703)308-1505  
For faxing of correspondence:  
Draft amendments only-(703)308-7769  
(Examiner should be notified of fax)  
Formal correspondence-(703)305-3579 or 305-3580  
RIGHT FAX-Before Final . . (703) 872-9302  
-After Final . . . (703) 872-9303  
(The examiner ordinarily will not retrieve formal correspondence)  
For petitions:

Application/Control Number: 09/599,274

Page 6

Art Unit: 3728

Before the Examiner . (703)308-1505  
Before the Group Director . (703)308-3872  
Other petitions . . . (703)305-9282



JIMMY G. FOSTER  
PRIMARY EXAMINER  
GROUP 3720

JGF  
April 3, 2003